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10/798,779	03/12/2004	David G. Filippi	COLME-0004	5631

7590  
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08/16/2007

EXAMINER
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CAJILIG, CHRISTINE T

ART UNIT	PAPER NUMBER
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3637

MAIL DATE	DELIVERY MODE
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08/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p align="center">10/798,779</p>	<p><b>Applicant(s)</b></p> <p align="center">FILIPPI, DAVID G.</p>	
	<p><b>Examiner</b></p> <p align="center">Christine T. Cajilig</p>	<p><b>Art Unit</b></p> <p align="center">3637</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-79 is/are pending in the application.
- 4a) Of the above claim(s) 39-41 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-63 and 65-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/> Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/> Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/29/07 has been entered.

### ***Response to Amendment***

Text of cancelled claims should not be included, but only have the status identifier. Claim 75 should have the correct status identifier of "currently amended."

The declaration under 37 CFR 1.132 filed 6/29/07 is insufficient to overcome the rejection based upon 35 U.S.C. 103(a) as set forth in the last Office action because:

Claims rejected under 35 U.S.C. 102 cannot be argued with respect to an affidavit. Moreover, the declaration does not set forth what rejection(s) the declaration is attempting to avert nor does the declaration set forth as to which claim(s) the declaration is directed.

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### ***Claim Objections***

Claims 46, 47, 58, 59, and 60 are objected to because of the following informalities: (1) In claims 46, 47, 59, and 69, the word "inch" should be deleted as the numbers presented refer to a ratio. (2) In claim 58, insert "the width" before "(D2)." (3) In claim 60, insert "the width" before (D2) and "the thickness" before "(D)." Appropriate correction is required.

The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters (such as in claim 57) corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42, 47, 52, 53, 58, 60, 63, 68, 69, 71-73, 76, 78, and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 42 and 63 appear to be directed toward a gutter-cover system comprising a gutter cover and a clip. However, it is unclear if Applicant intends to claim a kit with a gutter cover and a clip or an operable system tied together. It appears that Applicant intends to claim a gutter-cover system, however, it does not appear that the two elements (gutter cover and clip) are recited in positively in relation to each other (i.e. the throat portion of the clip is adapted to engage the curl of the cover).

Regarding claims 47, 53, 58, 60, 69, 73, 76, 78, and 79, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 47, 58, 60, 69, 72, 73, and 78, Applicant uses language, such as "the ratio of (D3) to (D)" in claim 47, "wherein (D2) is" in claim 58 or "the width of said second hinge is (D7)" in claim 72 renders the claim to be indefinite. It is unclear as to exactly what elements are being referred to. The elements that are represented by (D2), (D), etc. must be recited in the claim, for example, "--wherein the width (D2)--." Furthermore, it is unclear as to what is defined by (D7) in the language of "said second hinge is (D7)."

Claim 52 recites the limitation "the shortest distance (D4)" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 68 recites the limitation "the hinge width (D2)" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 71 recites the limitation "the width (D7) of said second hinge" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 78 recites the limitation "the width (D5)" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 79 recites the limitation "the distance (D8)" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42, 55, 61-62, 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Elko et al. (U.S. Patent No. 4,455,791).

Regarding claims 42 and 65, Elko et al. in Figure 7 discloses a gutter-cover system for spacing a wall of a gutter from a gutter cover comprising a cover (32), said cover comprising a solid sheet having one longitudinal edge thereof formed into a curl (33) and wherein the cover extends downwardly and outwardly from the lowermost edge of a roof so that said curl (33) extends downwardly toward said gutter; a gutter-cover clip (66) having a substantially flat body portion inherently having a thickness; said body portion providing a first planar side, a second planar side, and an outer edge, whereby the clip resides in a single plane; said body portion comprising a first throat portion (throat where 33 is located) having first (61) and second (62) jaws thereof and shaped so that said first throat portion is adapted to engage said curl (33) of said cover;

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third (63) and fourth (64) jaws and a second throat (throat where 25 is located) located therebetween, said second throat being adapted to engage said wall of said gutter between said third and fourth jaws; and, at least a first locking lever (60) adjacent said third jaw and joined to said body portion by a hinge (a), said first locking lever being adapted to be bent at said hinge to bring said third jaw into a locking position against said gutter as seen in Figure 7.

Regarding claim 55, Elko et al. in Figure 7 discloses a gutter-cover system wherein said clip is adapted to lock onto a vertical gutter wall portion (throat 40 in Figure 7 is capable of locking onto a vertical gutter wall depending on how the clip is oriented) and wherein said third and fourth jaws would be essentially parallel to said vertical gutter wall. No patentable weight is given to the structure of a gutter since the gutter is claimed as an intended use.

Regarding claim 61, Elko et al. discloses a gutter-cover system wherein said body portion is comprised of a flat piece of metal that is inherently bendable (Col 6, Ln 9-14).

Regarding claim 62, Elko et al. discloses a gutter-cover system wherein the deepest part of said first throat (throat where 33 is located) and the deepest part of said second throat (throat where 25 is located) lie essentially in a common plane.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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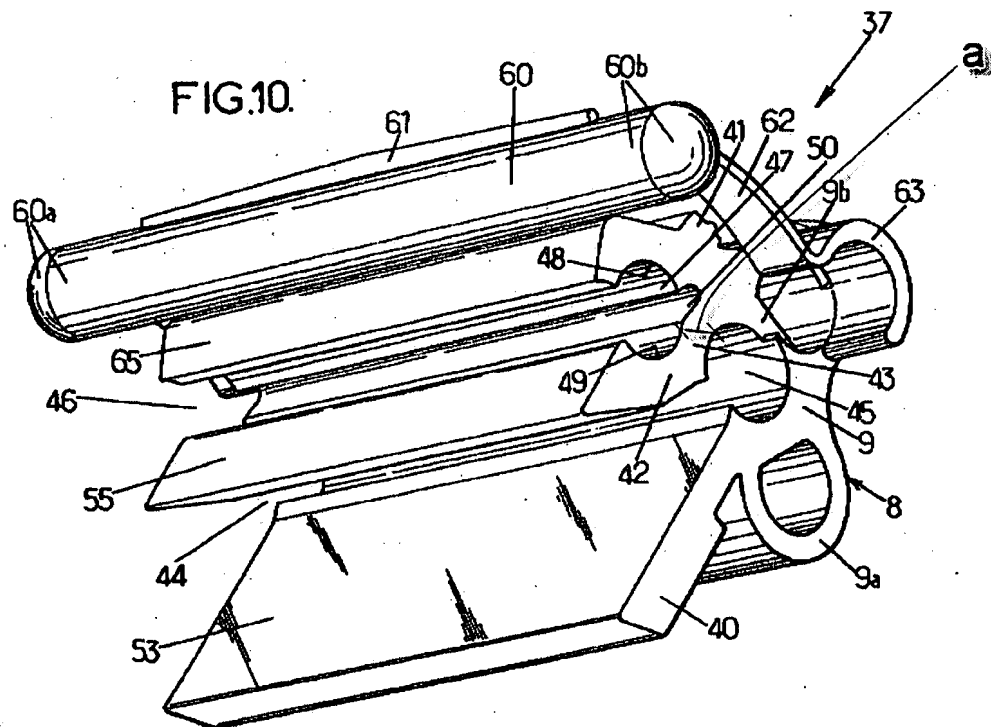
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-45, 56, 63, 67, and 74-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elko et al. (U.S. Patent No. 64,455,791) in view of Doussot et al. (U.S. Patent No. 5,426,832).

Regarding claim 43, Elko et al. discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion, said bending slot being located above said second throat so that said hinge is between said second throat and said bending slot, said hinge having a width whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37), said bending slot (46) being located above a second throat (45) so that a hinge (43) is between said second throat (45) and said bending slot (46) and having a width (a) whereby a force applied to said bending slot (46) moves a locking lever (55) about said hinge (43) so that a third jaw (57) is brought into locking engagement with a rod (4). Elko et al. and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Elko et al. to include a bending slot in said body portion, said bending slot being located above said second throat so that said hinge is between said second throat and said bending slot and having a width (D3)



whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17).



Doussot et al. (U.S. Patent No. 5,426,832)

Regarding claim 44 and 45, Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width of said hinge (D3) is between about 1/16 inch and 7/64 inch, preferably about 3/32 inch. It would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Doussot et al. to have the width of

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said hinge (D3) to be between about 1/16 inch and 7/64 inch, preferably about 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 56, Elko et al. discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion located adjacent said third jaw so that said hinge is between said third jaw and said bending slot whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37) located adjacent said third jaw (57) so that a hinge (43) is between said third jaw (57) and said bending slot (46) and having a width (a) whereby a force applied to said bending slot (46) moves a locking lever (55) about said hinge (43) so that a third jaw (57) is brought into locking engagement with a rod (4). Elko et al. and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Elko et al. to include a bending slot in said body portion located adjacent said third jaw so that said hinge is between said third wall and said bending slot whereby a force applied to said bending slot moves said locking

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lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17).

Regarding claims 63 and 67, Elko et al. discloses a gutter-cover system for spacing a wall of a gutter from a gutter cover comprising a cover (32), said cover comprising a solid sheet having one longitudinal edge thereof formed into a curl (33) and wherein the cover extends downwardly and outwardly from the lowermost edge of a roof so that said curl (33) extends downwardly toward said gutter; a gutter-cover clip (66) having a substantially flat body portion inherently having a thickness; said body portion providing a first planar side, a second planar side, and an outer edge, whereby the clip resides in a single plane; said body portion comprising a first throat portion (throat where 33 is located) having first (61) and second (62) jaws thereof and shaped so that said first throat portion is adapted to engage said curl (33) of said cover; third (63) and fourth (64) jaws and a second throat (throat where 25 is located) located therebetween, said second throat being adapted to engage said wall of said gutter between said third and fourth jaws; and, at least a first locking lever (60) adjacent said third jaw and joined to said body portion by a hinge (a), said first locking lever being adapted to be bent at said hinge to bring said third jaw into a locking position against said gutter as seen in Figure 7, but does not disclose a gutter-cover system further including a bending slot in said body portion located above said second throat and wherein the ratio of the distance between said first throat and said bending slot to the thickness of said hinge is between about 1.1 and 2.0 or 1.5. However, Doussot et al. in

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Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37), and said bending slot (46) being located above a second throat (45). Elko et al. and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Elko et al. to include a bending slot in said body portion and said bending slot being located above said second throat as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of invention to have the ratio of the distance between said first throat and said bending slot to the thickness of said hinge to be between about 1.1 and 2.0 or 1.5, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233.

Regarding claim 74, Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width of said hinge (D3) is between about 1/16 inch and 3/32 inch. It would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Doussot et al. to have the width of said hinge (D3) to be between about 1/16 inch and 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in

size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 75, Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above and further discloses that said first hinge (a) is between said second throat and said bending slot, and said third jaw clamps onto said wall of said gutter upon insertion and rotation of a bending tool in said bending slot per the modification in claim 63, but does not disclose a width (D6) being the shortest distance between said first throat and said bending slot. However, it would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Doussot et al. to have a width (D6) being the shortest distance between said first throat and said bending slot, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. The phrase "upon insertion and rotation of a bending tool in said bending slot" is regarded to as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP §2114. Furthermore, the third jaw could perform the function stated above if any tool applies downward pressure.

Regarding claim 76, Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width (D6) is preferably about 15/128 inch. It would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Doussot et

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al. to have the width (D6) preferably about 15/128 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 77 and 78, Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the ratio of the width (D6) to the width (D5) is between about 1.1 and 2.0, or about 1.5. It would have been obvious to one having ordinary skill in the art at the time of invention to have the ratio of the width (D6) to the width (D5) is between about 1.1 and 2.0, or about 1.5, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 79, Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the distance (D8) between said first throat (36) and said second throat (c) is 19/128 inch. It would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Doussot et al. to have the distance (D8) between said first throat and said second throat to be 19/128 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away

from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 49, 50 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elko et al. in view of Holbrook (U.S. Patent No. 6,347,780 B1).

Regarding claims 50 and 54, Elko et al. discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including at least one of said jaws being serrated. However, Holbrook in Figure 6 discloses gutter hanger clip including two serrated jaws. Elko et al. and Holbrook are analogous art because they are pertinent in the problem of clamping the top front wall of the gutter. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Elko et al. to include serrations in the third and fourth jaws as taught by Holbrook to provide better retention of the clip when in contact with the gutter surface (Col 3, Ln 9-11 and Ln 45-48).

Regarding claim 49, Elko et al. already modified by Doussot et al. discloses the gutter-cover system as discussed above but does not disclose the gutter-cover system further including a recess in said third jaw for accommodating an unlocking tool for pivoting said locking lever about said hinge to move said third jaw out of engagement with said gutter. However, Holbrook in Figure 6 discloses gutter hanger clip including two serrated jaws, the serrations providing recesses in the jaw. Elko et al. and Holbrook are analogous art because they are pertinent in the problem of clamping the top front wall of the gutter. Therefore, it would have been obvious to a person having ordinary

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skill in the arts at the time of the applicant's invention to modify the clip of Elko et al. to include serrations in the third jaw, which would provide a recess as taught by Holbrook to provide better retention of the clip when in contact with the gutter surface (Col 3, Ln 9-11 and Ln 45-48).

Claims 51-53, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elko et al. in view of page 4 of Applicant's Response to Restriction Requirement expressly admitting that Groups 2-7 (Figures 5-12) are "obvious over each other within the meaning of 35 U.S.C. 103."

Regarding claim 51, Elko et al. discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including fifth and sixth jaws and a second locking lever adjacent said fifth jaw and joined to said body portion by a second hinge, said second locking lever being adapted to be bent at said second hinge to bring said fifth jaw into a locking position against a vertical wall of said gutter. However, per Applicant's admission in page 4, including fifth and sixth jaws and a second locking lever adjacent said fifth jaw and joined to said body portion by a second hinge would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts, such as the duplication of the jaws, has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).



Regarding claims 52 and 53, Elko et al. already modified by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including a third throat portion between said fifth and said sixth jaws and wherein the shortest distance (D4) between said first throat and said third throat is between about 1/8 and 7/16 inch, preferably about 5/16inch. However, per Applicant's response in page 4, including a third throat portion between said fifth and said sixth jaws and wherein the shortest distance (D4) between said first throat and said third throat is between about 1/8 and 7/16 inch, preferably about 5/16inch would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955). Moreover, it would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Figures 5-11 of the Applicant's disclosure to have the shortest distance (D4) between said first throat and said third throat to be between about 1/8 and 7/16 inch, preferably about 5/16inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 57 and 58, Elko et al. already modified by Figures 5-11 of the Applicant's disclosure discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including a third throat and wherein a second hinge having a width (D2) is formed between said third throat and said third jaw, said second hinge and wherein the width (D2) of said second hinge is between about 1/16 inch and 5/32 inch, preferably about 3/32 inch. However, per Applicant's response in page 4, including a third throat and wherein a second hinge having a width (D2) is formed between said third throat and said third jaw, said second hinge and wherein the width (D2) of said second hinge is between about 1/16 inch and 5/32 inch would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955). Moreover, it would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Figures 5-11 of the Applicant's disclosure to have the width (D2) of said second hinge to be between about 1/16 inch and 5/32 inch, preferably about 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elko et al. in view of page 4 of Applicant's Response to Restriction Requirement expressly admitting that Groups 2-7 (Figures 5-12) are "obvious over each other within the meaning of 35 U.S.C. 103" as applied to claim 57 above, and in further view of Applicant's admitted prior art in pages 2 and 3 and Figure 1 of Applicant's disclosure.

Regarding claims 59 and 60, Elko et al. already modified by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above, and further discloses that the clip has a thickness of 0.3 cm (Col 6, Ln 13 of Elko et al.) but does not disclose the gutter-cover system wherein the ratio of the hinge-width to the thickness of said body portion is between about 0.25 and 1.2 inch, preferably about 0.94 inch. However, pages 3 and Figure 1a of Applicant's disclosure discloses a prior art clip (34a) by another having a hinge width (D1) of between 0.32 cm and 0.8 cm. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the clip of Elko et al. to have a hinge width of between 0.32 cm and 0.8 cm as taught by pages 3 and Figure 1 of Applicant's admitted prior art in order to provide a substantial hinge width that could withstand bending or handling without breaking apart from the clip body. Such a modification of the hinge width would provide a hinge width to thickness ratio of about 1, which falls within the range of 0.25 and 1.2 and is about 0.94.

Claims 49, 66, and 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elko et al. in view of Doussot et al. and in further view of page 4 of

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Applicant's Response to Restriction Requirement expressly admitting that Groups 2-7 (Figures 5-12) are "obvious over each other within the meaning of 35 U.S.C. 103."

Regarding claim 49, Elko et al. already modified by Doussot et al. discloses the gutter-cover system as discussed above but does not disclose the gutter-cover system further including a recess in said third jaw for accommodating an unlocking tool for pivoting said locking lever about said hinge to move said third jaw out of engagement with said gutter. However, per Applicant's response in page 4, including a recess in said third jaw would have been obvious in view of Figures 8 and 9 in the Applicant's disclosure for accommodating an unlocking tool for pivoting said locking lever about said hinge to move said third jaw out of engagement with said gutter.

Regarding claim 66, Elko et al. discloses a gutter-cover clip for spacing a wall of a gutter from a gutter cover comprising a cover (32), said cover comprising a solid sheet having one longitudinal edge thereof formed into a curl (33) and wherein the cover extends downwardly and outwardly from the lowermost edge of a roof so that said curl (33) extends downwardly toward said gutter; a gutter-cover clip (66) having a substantially flat body portion inherently having a thickness; said body portion providing a first planar side, a second planar side, and an outer edge, whereby the clip resides in a single plane; said body portion comprising a first throat portion (throat where 33 is located) having first (61) and second (62) jaws thereof and shaped so that said first throat portion is adapted to engage said curl (33) of said cover; third (63) and fourth (64) jaws and a second throat (throat where 25 is located) located therebetween, said second throat being adapted to engage said wall of said gutter between said third and

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fourth jaws; and, at least a first locking lever (60) adjacent said third jaw and joined to said body portion by a hinge (a), said first locking lever being adapted to be bent at said hinge to bring said third jaw into a locking position against said gutter as seen in Figure 7, but does not disclose a gutter-cover clip further including a bending slot in said body portion located above said second throat and wherein the ratio of the distance between said first throat and said bending slot to the thickness of said hinge is between about 1.1 and 2.0 or 1.5; and fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and sixth jaws. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37), and said bending slot (46) being located above a second throat (45). Elko et al. and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Elko et al. to include a bending slot in said body portion and said bending slot being located above said second throat as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of invention to have the ratio of the distance between said first throat and said bending slot to the thickness of said hinge to be between about 1.1 and

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2.0 or 1.5, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. However, per Applicant's response in page 4, including fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and sixth jaws would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Regarding claim 70, Elko et al. already modified by Doussot et al. discloses the gutter-cover system as discussed above but does not disclose the gutter-cover system further including fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and sixth jaws. However, per Applicant's response in page 4, including fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical

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wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and sixth jaws would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Regarding claim 71, Elko et al. already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width (D7) of said second hinge is preferably about fraction  $11/128$  inch. It would have been an obvious matter of design choice to modify the clip of Elko et al. already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure to have the width (D7) of said second hinge to be preferably about fraction  $11/128$  inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 72 and 73, Elko et al. already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system that the ratio of a

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distance between the first and second throats (D8) to a width of the second hinge (D7) is between about 1.1 and 2.0, preferably about 1.5. It would have been obvious to one having ordinary skill in the art at the time of invention to have the ratio of a distance between the first and second throats (D8) to a width of the second hinge (D7) is between about 1.1 and 2.0, preferably about 1.5, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 46, 47, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elko et al. in view of Doussot et al. as applied to claims 42 and 63 above, and in further view of Applicant's admitted prior art in pages 2 and 3 and Figure 1 of Applicant's disclosure.

Regarding claims 46, 47, 68, and 69 Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above, and further discloses that the thickness of the clip is 0.3 cm (Col 6, Ln 13 of Elko et al.) but does not disclose the gutter-cover system wherein the ratio of the hinge width (b) to the thickness of said body portion is between about 0.25 and 1.2. However, pages 3 and Figure 1a of Applicant's disclosure discloses a prior art clip (34a) by another having a hinge width (D1) of between 0.32 cm and 0.8 cm. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the clip of Elko et al. to have a hinge width of between 0.32 cm and 0.8 cm as taught by pages 3 and Figure 1 of Applicant's admitted prior art in order to provide a substantial hinge



width that could withstand bending or handling without breaking apart from the clip body. Such a modification of the hinge width would provide a hinge width to thickness ratio of about 1, which falls within the range of 0.25 and 1.2 and is about 0.94.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elko et al. in view of Doussot et al. as applied to claim 42 above, and in further view of Stevens (U.S. Patent No. 6,735,907 B2).

Regarding claim 48, Elko et al. already modified by Doussot et al. discloses a gutter-cover system as discussed above, but does not disclose a locking slot capable of accommodating a locking-unlocking tool for selectively pivoting said locking lever about said hinge and into a lock or unlocked position. However, Stevens discloses a gutter clip comprising a locking slot (56) capable of accommodating a tool to facilitate placement of the clip onto a gutter and a gutter cover. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention to modify the clip of Elko et al. to have a locking slot as taught by Stevens to provide a means that can accommodate a tool to facilitate placement of the clip onto a gutter and gutter cover (See Col 9, Ln 4-9 of Stevens).

### ***Response to Arguments***

Applicant's arguments with respect to claims 42-63 and 65-79 have been considered but are moot in view of the new ground(s) of rejection.

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In response to Applicant's argument on page 27 of the Remarks with respect to the change in size to achieve the size of the width claimed by Applicant, although the prior art does not recite specific dimensions, the scaling up or down of the clip would indeed result in a hinge or width size claimed by Applicant, as such, to have those dimensions would have been obvious.

Applicant's arguments with respect to the ratios relating the dimensions of the clip have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that Stevens and Doussot et al. and Holbrook is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Doussot et al. discloses a clip for use in a vehicle seat. Doussot et al.'s clip is used to securely engage a rod (4) by locking the rod in the throat of the clip via a lever (42), thus securing it in place. Moreover, both Stevens and Doussot et al. solve the problem of securing a member in the jaws of a clip. Holbrook discloses a hanger clip to securely fasten lights onto a gutter. Holbrook's clip uses serrated teeth on its jaws to securely engage a gutter. Moreover, both Stevens and Holbrook solve the problem of securing a member in the jaws of a clip. Furthermore, classification is not conclusive evidence of whether art is analogous or not. See MPEP 2141.01. Thus, the Examiner maintains that all clips that are capable of

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holding on to a structure are in Applicant's field of endeavor. Accordingly, the Stevens, Doussot et al., and Holbrook are analogous.

Applicant on page 27 of the Remarks argues that Doussot does not teach a resilient locking lever and that Doussot's bending slot is only operable when structure from the associated seat is selectively placed in the slot. The structure or rod placed in the bending slot of Doussot merely assures that the element (4) is more securely held in place. Otherwise, the teaching of a locking groove and press fit lock is taught by Doussot.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Cajilig whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday - Friday from 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571)272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/CTC/  
8/13/07

LANNA MAI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

A handwritten signature in black ink, appearing to read "Lanna Mai", written in a cursive style.